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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,317	02/01/2005	Yoshio Takamura	114216-019	7655

43793 7590 11/28/2006

EVEREST INTELLECTUAL PROPERTY LAW GROUP

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NORTHBROOK, IL 60065

EXAMINER

BRITTAIN, JAMES R

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/523,317

Applicant(s)

TAKAMURA ET AL.

Examiner

James R. Brittain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

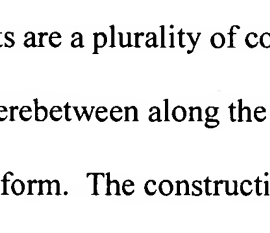
The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 3-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 includes the alternative recitation of the “crimping parts” found in lines 14-19 as reproduced below:

crimping parts are formed on one of an inner periphery of the opening of an outer peripheral surface of the shaft at specified positions with a prespecified space therebetween in the circumferential direction so as to crimp into or crimped by the other, and the crimping parts are a plurality of convex parts formed at prespecified positions with a prespecified space therebetween along the inner periphery of the opening or, when the opening has a polygonal shape, respective sides of the polygonal shape.



The language is so unclear with so many alternatives and the last three lines with the term “when” makes the claim construction time dependent as to render the claims of unclear scope. It is suggested that the alternative embodiments be defined in separate independent claims so that it is at least clear that “the crimping parts are a plurality of convex parts formed at prespecified positions with a prespecified space therebetween along the inner periphery of the opening” is required and not placed in alternative form. The construction of this independent claim renders the dependent claims indefinite because there is no disclosure for all of the embodiments of the independent claim, so far as definite, as each having the structure set forth in the independent

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claim. Applicant has created a claim construction that mixes the species in a manner that is misdescriptive.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 4 recites the "convex parts", however, claim 1 recites that the opening can have a polygonal shape and there is no disclosure of the sides of the polygonal shape comprising "convex parts". Therefore, claim 4 doesn't have disclosure in the application as filed for further limiting an embodiment with an opening having a polygonal shape as described in claim 1. Claim 5 recites the opening being a "pentagonal shape", however, claim 1 recites that the crimping parts are a plurality of convex parts formed at prespecified positions with a prespecified space therebetween along the inner periphery of the opening and there is no disclosure of the sides with a plurality of convex parts as recited being associated with an opening having a "pentagonal shape". Therefore, claim 5 doesn't have disclosure in the application as filed for further limiting an embodiment with crimping parts being a plurality of convex parts formed at prespecified positions with a prespecified space therebetween along the inner periphery of the opening as described in claim 1. Claim 6 recites the opening has "a round form", however, claim 1 recites that the opening can have a polygonal shape and there is no disclosure of the sides of

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the polygonal shape comprising “a round form”. Therefore, claim 6 doesn’t have disclosure in the application as filed for further limiting an embodiment with an opening having a polygonal shape as described in claim 1.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following comments directed to features found in claims 4-6 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim 4 recites the “convex parts”, however, claim 1 recites that the opening can have a polygonal shape and there is no disclosure of the sides of the polygonal shape comprising “convex parts”. Therefore, claim 4 isn’t shown in the drawings as filed for further limiting an embodiment with an opening having a polygonal shape as described in claim 1. Claim 5 recites the opening being a “pentagonal shape”, however, claim 1 recites that the crimping parts are a plurality of convex parts formed at prespecified positions with a prespecified space therebetween along the inner periphery of the opening and there is no disclosure of the sides with a plurality of convex parts as recited being associated with an opening having a “pentagonal shape”.

Therefore, claim 5 isn’t shown in the drawings as filed for further limiting an embodiment with crimping parts being a plurality of convex parts formed at prespecified positions with a prespecified space therebetween along the inner periphery of the opening as described in claim 1.

Claim 6 recites the opening has “a round form”, however, claim 1 recites that the opening can have a polygonal shape and there is no disclosure of the sides of the polygonal shape comprising

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“a round form”. Therefore, claim 6 isn’t shown in the drawings as filed for further limiting an embodiment with an opening having a polygonal shape as described in claim 1.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candotti (US 5575043) in view of Kanzaka (US 4387488).

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Candotti (Figures 1-6) teaches button structure with a polygonal shaft 15 placed in the shell member 12 having a cylindrical neck 12b and the tapered portion 12c is crimped inwardly. The tack holds the button to the fabric. The shaft 15 protrudes outwardly from the crimped portion 12c. Applicant has written claim 1 to be of alternative construction such that the crimping parts can be sides of a polygonal shaped opening in the shell member. The difference from Candotti is that shell member has a circular opening, not polygonal. However, Kanzaka (figures 2, 7, 13, 14) teaches that rather than using a circular geometry for the interior opening 77 of the shell gripping member 74 as shown in figures 13 and 14, that it is desirable to use a square geometry for the interior opening 34 of the shell gripping member 28 so as to provide desirable gripping characteristics. Therefore, it would have been obvious to modify the button of Candotti so that the shell member has a polygonal opening in view of Kanzaka teaching such structure to be desirable on buttons. As claim 3 no longer requires that the crimping parts are a plurality of convex parts formed at prespecified positions with a prespecified space therebetween along the inner periphery of the opening only that there be a polygonal opening, it is now rejected because it is of broader scope than claim 3 as filed and Candotti and Kanzaka clearly show that the shafts can have a round cross-section. As to claim 6, the use of five sides on the shaft rather than four would have been an obvious extension of the teachings of Candotti wherein the corners of the shaft are desirably engaged by the crimped circular portion 12c. As to claim 8, insofar as the shaft of Candotti is polygonal it defines gaps along the faces away from the corners of the shaft that would read on the claim construction. In regard to claim 9, figure 3 of Candotti shows tread 20 with a specified angular space and protrusions 26 and an annular rim on the head of the tack.

Response to Arguments

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Applicant's arguments filed September 19, 2006 have been fully considered but they are not persuasive. Applicant has chosen a claim construction that may have reduced the number of claims by creating a catch-all independent claim, but has done so at the expense of clarity of claim construction. The result is misdescriptiveness and a set of rejections and objections stemming from this new claim construction. Kanzaka has been utilized to address the new limitation placed in claim 1 of a "polygonal shape" that is of a different scope than that of claim 5.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

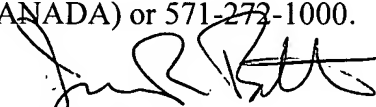
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is (571) 272-7065. The examiner can normally be reached on M-F 5:30-2:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



James R. Brittain
Primary Examiner
Art Unit 3677

JRB